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PATENT

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Applicant	:	Hasper et al.)	Group Art Unit 3652
)	
Appl. No.	:	09/807,580)	I hereby certify that this correspondence
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		FOR HANDLING THEREOF)	Office, P.O. Box 1450, Alexandria, VA
)	22313-1450, on
)	<u>July 6, 2004</u>
)	(Date)
Examiner	:	Charles A. Fox)	<u>Adeel S. Akhtar</u>
)	Adeel S. Akhtar, Reg. No. 41,394

REPLY BRIEF AND REQUEST FOR ORAL HEARING

MAIL STOP APPEAL BRIEF - PATENTS

U.S. Patent and Trademark Office

P.O. Box 1450

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Dear Sir:

In response to the Examiner's Answer in this Appeal, mailed on May 6, 2004, Appellants reply as follows:

I. Arguments Raised by Examiner's Answer

A. The art of record does not teach any particular arrangement for combining the measuring station of Cheng and the wafer sorter of Allen with Muka's apparatus.

The Examiner has agreed with Appellants' characterization of Cheng, Allen and Muka. The Examiner has agreed that Cheng, Allen and Muka do not teach combining the features disclosed by those references in any particular manner. Regarding Cheng and Allen, the Examiner has stated that Cheng and Allen "do not teach a particular structure for the combination of their device with an existing device." The Examiner has also stated that "neither Cheng or Allen provide explicit [sic] details on how their device would be combined with existing wafer handlers." Examiner's Answer, p. 7. Regarding Muka, the Examiner has not

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asserted that Muka teaches or suggests any particular manner of combining its apparatus with a wafer measuring station or a wafer sorter.

The Examiner has also noted Applicants' argument, *i.e.*, that while Muka, Cheng and Allen collectively teach a cassette store with cassettes, a sealable chamber, a cassette-handling device, a wafer measuring station and a wafer sorting device, the art of record neither teaches nor suggests how these features would be arranged in a combination. In response, the Examiner has stated that "[t]his is true." Examiner's Answer, p. 9.

B. The claims at issue do not specify any particular arrangement of features; as a result, any combination of Muka's apparatus with a measuring station and a wafer sorter meets all limitations of the claims.

The Examiner has argued that "claim 8 does not claim any particular arrangement for the elements in the instant application ... In short [Appellants'] argument is moot." The Examiner has also argued that "one of ordinary skill in the art would have been able to conceive of a manner of combining the devices" disclosed by Cheng, Allen and Muka. As a result, the Examiner has argued that the claims are obvious. Examiner's Answer, pp. 9-10.

By these statements, the Examiner has implicitly argued that, because no particular arrangement of features is recited, the claims are met by any combination of references that teaches using a measuring station and a wafer sorter within a single factory with Muka's apparatus.

C. Appellants agree with the Examiner that the combination of references teach all the limitations of Claim 8.

The Examiner has argued that Appellants have admitted that the combination of Cheng, Allen and Muka teach all limitations of Claim 8. Examiner's Answer, p. 7. Thus, the Examiner has argued that Appellants' argument—that the combination of Cheng, Allen and Muka, do not teach all limitations of the claims—is moot.

II. Reply to Arguments

A. The only pending issue is whether the claims recite a particular arrangement of features.

Appellants agree with the Examiner's statement that Cheng, Allen and Muka do not teach any particular arrangement of features. Because of this deficiency, Cheng, Allen and Muka do not meet all limitations of the claims, and the rejections are improper, if a particular arrangement of features is a limitation of the claims. Accordingly, the only pending issue in this appeal is whether the claims specify a particular arrangement of claimed features.

B. The claims do recite a particular arrangement of the claimed features, with a common wafer handling device.

Appellants submit that the claims do recite a specific arrangement of claimed features interconnected by a common wafer handling device. For example, independent Claim 8 recites a "store for closable cassettes" and a "handling device" for the closable cassettes, both of which are in a common "housing." In addition, the housing is separated by a "partition" from a "chamber configured to be sealed off with respect to the housing," the "chamber" holding the "wafer handling device." Through the "partition," a "wafer handling device can remove wafers from the cassette or position them therein." Moreover, "*the* wafer-handling device accesses a measuring station" and "*the* wafer-handling device is adapted to transfer the wafers directly between cassettes in a sorting function." (emphasis added). Consequently, Claim 8 specifies an arrangement in which the wafer-handling device in the sealable chamber connects various other features; that is, the measuring station, the cassettes and the partition are arrayed, relative to the wafer-handling device and to the sealable chamber, so that a *single* wafer-handling device can *both* access the measuring station *and* sort the wafers by transferring the wafers directly between cassettes.

Independent Claims 13 and 15 recite a similar arrangement of features interrelated by a common wafer handling device. For example, Claim 13 recites "plac[ing]" "first" and "second" cassettes in "active communication with said wafer handling device," "transferring wafers to and from a measuring station with the wafer-handling device" and "employing said wafer-handling device to sort the wafers by transferring wafers directly between the first cassette and the second cassette." Similarly, Claim 15 recites "mov[ing] a first" and a "second cassette" to "closable

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opening[s] in a sealed chamber” and “employing a wafer-handling device, provided in said sealed chamber, to transfer wafers to and from a measuring station communicating with said sealed chamber and to sort the wafers by transferring wafers directly between the first cassette and the second cassette.” Clearly, to place or move cassettes to a location where the cassettes can be accessed by a wafer handling device that sorts wafers between cassettes *and* that transfers them to a measuring station, the measuring station and cassettes are necessarily in a physical arrangement that facilitates access by the common wafer handling device.

Accordingly, all independent claims at issue specify a particular arrangement of a *single* wafer handling device relative to a measuring station and cassettes for wafer sorting.

C. The claims are not obvious over the art of record because Muka, Cheng and Allen do not teach or suggest the claimed arrangement of features.

The claims clearly specify an arrangement in which a measuring station and cassettes, between which wafers are sorted, are positioned to interface with a common wafer handling device. Consequently, to establish a *prima facie* case of obviousness, it is not enough for Cheng, Allen and Muka to simply teach individual elements of the claims. Rather, the references must also teach or suggest arranging these elements in the *particular manner* claimed by Appellants. *See, e.g., In re Kotzab*, 55 U.S.P.Q. 2d 1313, 1318 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination *in the manner claimed.*”) (emphasis added); *see also* M.P.E.P. § 2143.01 (“the mere fact that references can be combined or modified does not render the resultant combination obvious, unless the prior art also suggests the *desirability* of the modification.”) (emphasis added) (citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)).

In this case, Cheng, Allen and Muka simply do not teach or suggest the claimed arrangement. This deficiency is admitted by the Examiner himself. Examiner’s Answer, pp. 7 and 9. Thus, even if the skilled artisan were motivated, as asserted by the Examiner, to measure and sort wafers in a factory having Muka’s apparatus, the combination of Cheng, Allen and Muka does not teach arranging a measuring station and cassettes for wafer sorting around a *common* wafer handling device. Moreover, the art of record does not teach or suggest using a single wafer handling device, held in a sealable chamber, to both access a measuring station and

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to sort wafers directly between cassettes. As a result, even if properly combined, the art of record fails to teach or suggest all limitations of the claims.

Accordingly, Appellants submit that the claims are not obvious over the art of record.

D. Appellants have not admitted that the combination of Muka, Cheng and Allen teaches all limitations of Claim 8.

While Appellants agree that the art of record teaches *certain* elements of the claims, Appellants have not stated that Muka, Cheng and Allen teach *all* elements of the claims. In making such an assertion, the Examiner has taken Appellants' statements out of context.

The Examiner has pointed to the Appeal Brief, Subsection A, first line, as admitting that Muka, Cheng and Allen together teach all limitations of Claim 8. This is incorrect. The first line of Subsection A actually states that "Applicants do not argue here that Muka, Cheng, and Allen lack the features discussed above." Coming in the first line of Subsection A, this statement is clearly a reference to the previous section. In that previous section, Appellants note that the "Examiner has asserted Muka for teaching an apparatus having, *inter alia*, a cassette store, a sealable chamber and a cassette-handling device. Cheng has been asserted for teaching a measuring station and Allen has been asserted for teaching a wafer sorting device." Appellants' Appeal Brief, p. 4. Thus, Appellants' clearly have not agreed that Muka, Cheng and Allen teach *all* elements of the claims.

In fact, in the very next line of Subsection A, Appellants state that "even assuming that the prior references are properly combined and that the prior art teaches all the asserted individual components of the claims, Appellants submit that the art of record does not establish a *prima facie* case of obviousness because the prior art does not teach or suggest each limitation of the claims." Accordingly, read in context, Appellants have stated nothing more than that Muka, Cheng and Allen teach, individually, certain features of the claims, but do not teach *all* features.

III. Conclusion

In view of the foregoing arguments, Appellants respectfully submit that the rejections of the pending claims are improper and should be withdrawn.

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IV. Request for Oral Hearing

Pursuant to 37 C.F.R. § 1.194, Appellants respectfully request an Oral Hearing in this Appeal. This Request is also made in a separate paper filed herewith, and is accompanied by the fee set forth in 37 C.F.R. §1.17(d).

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: July 6, 2004

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